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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,838	04/18/2005	Thomas Aue	SCH-15950	4317
40854	7590	08/16/2007	EXAMINER	
RANKIN, HILL, PORTER & CLARK LLP			NIA, ALIREZA	
38210 Glenn Avenue			ART UNIT	PAPER NUMBER
WILLOUGHBY, OH 44094-7808			3709	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/531,838	AUE ET AL.	
	Examiner Alireza Nia	Art Unit 3709	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 9<sup>th</sup> August 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,8 and 9 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4,7, and 10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 April 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of species I and sub-species A in the reply filed on August 9<sup>th</sup>, 2007 is acknowledged.
2. Claims 5, 6, 8, and 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species and sub-species, there being no allowable generic or linking claim.

### ***Claim Objections***

3. In claim 2, the dependence of the claim as depicted by "claim (1)" is incorrect. It must be corrected to state "claim 1" if claim dependency is designated.

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "12" has been used to designate both circumferential angular positioning device (claim 1 line 7) and webs (page 7 line 4). Furthermore, reference item 12 in the claims are referred to through a plurality of descriptions (i.e. support device, circumferential angular positioning device, fixed webs, webs) which renders the claims objectionable. Moreover, the drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference characters 9 and 11 stated in claim 1 and reference character 19' as stated in claim 2. Appropriate correction is required.

5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing

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sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to because on page 6 of the specification where a brief description of the drawings are given, no description for figure 1 in the drawings is given. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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7. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

8. The disclosure is objected to because of the following informalities: plurality of typos exist in the specification (page 7, lines 13 and 18). Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Widran US 3,900,022, that teaches the invention as claimed.

11. Widran teaches a urological resectoscope 20 including a tubular shaft 24 through which an optical system 28 and a longitudinally moveable instrument carrier 46 pass (col. 2, lines 29-31 and 34-38), the optical system 28 being supported with respect to the tubular shaft 24 at a spacing from the proximal end of the tubular shaft 24 with a support device 60, 62 via 26, 34 (col. 2, lines 37-38 and 63-65) and the carrier 46 being positioned with a radial positioning

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device 48, 52 (col. 2, lines 45-47) and a circumferential angular positioning device 26 (fig. 2), wherein the support device 60, 62 is so arranged adjacent to the optical system 28 in the region in which the carrier 46 extends (fig. 20), that it supports the optical system 28 via 26, 34 with respect to the tubular shaft 24 with a two point support system 60, 62 and imparts lateral guide (fig. 1 and fig. 2) to the carrier 46 in the circumferential angular direction. Widran also teaches the support device 60, 62 having two circumferentially spaced fixed webs 60, 62 where each web 60 and 62 is arranged to be in contact with the optical system 28 via 26, 34 and the tubular shaft 24 (col. 2, line 68 and col. 3, lines 1-4) as well as on both sides of the carrier 46 and in sliding contact with it via 26 (fig. 2).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widran US 3,900,022.

14. Windran discloses the invention as discussed above with the exception of positively depicting the construction/projection of the support device such that it brings the optical system into engagement with the side of the tubular shaft in a three point support system. It would have been obvious to one of ordinary skill in the art at the time of the invention to have optimized the range of projection of the support system to bring the optical system into engagement with the

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side of the tubular shaft 24. Thus, it has been held, “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (MPEP 2144.05 II A). Furthermore, with respect to claim 2, it has been held that rearranging parts of an invention involves only routine skill in the art, In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (MPEP 2144.04 VI C).

15. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Widran US 3,900,022 in view of Wappler US 3,752,159.

16. Widran discloses the invention as discussed above with the exception of the following claimed limitation taught by Wappler: strip 19 (fig. 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the device of Widran in view of the limitation taught by Wappler in order to provide a resectoscope with means for supporting the arms intermediate their ends rendering more stability, as taught by Wappler (col. 2, lines 7-8 et seq. lines 11-13).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alireza Nia whose telephone number is 571-270-3076. The examiner can normally be reached on Mo.-Fri.-7:30 AM-5:00 PM EST-Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenburg can be reached on 571-272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information

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Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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